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Resp. dated Jan. 16, 2007

## REMARKS

The October 18, 2006 Final Action objected to claim 10 and rejected all claims pending in the application under §102. This Response cancels claims 3 and 10, amends claims 1 and 14, and submits arguments for the Examiner's consideration. Applicant respectfully requests that the Examiner reconsider the objection and withdraw the rejections.

## Claim Objection

The Action objects to claim 10. Applicant herein cancels claim 10 and requests the Examiner to reconsider the objection.

## Claim Rejections –35 USC§102

All claims, 1-18, stand rejected under 35 U.S.C. §102 as being anticipated by U.S. Application Publication. No. 2004/0196963 to Appelman et al. and U.S. Application Publication No. 2002/0034281 to Isaacs et al. For the following reasons Applicant respectfully traverses these rejections.

### Appleman et al.

The Appelman Patent Application was filed on December 30, 2003 and claims priority under 35 U.S.C. §119(e) to Appelman Provisional Application No. 60/459,273 filed on April 2, 2003. Applicant's application under examination was filed on October 29, 2003, prior to the Appelman Patent Application filing date but after the Provisional filing dates.

In Applicant's October 27, 2005 response, Applicant submits that additional subject matter was included in the Appelman Patent Application that is not supported by the earlier filing date of the Appelman Provisional. In Applicant's July 31, 2006 response, Applicant submits that the Appelman Provisional fails to disclose *a viewable call control option* as recited in Applicant's clams. In the Final Action, the Examiner disagreed by stating that the Appelman Provisional (in particular, claims 3, 4 and 8 and specification page 4) discloses "an instant message and email message" and this "implies that they are viewable." For the reasons stated herein, Applicant submits that the above-referenced sections of the Appelman Provisional *are not analogous to*

*Applicant's claimed "viewable call control option."* Moreover, Appelman fails to disclose receiving *an alert comprising an informational status message pertaining to the contact and delivered to the user unbeknownst to the contact.* Thus, Appelman fails to support each and every element of Applicant's claims.

## Appelman Provisional Application "Concatenated Ring Tones"

Briefly, the Appelman Provisional Application discloses defined sounds concatenated with ring tones to assist the call recipient in identifying the caller. For example, the tail end of the ring tone is customized to include the defined sound and, by playing the sound, serves to identify the caller. Thus, by listening to the particularized audible sounds, the call recipient is able to identify who is calling before answering the call. The concatenated ring tones may be used in an instant messaging context to provide concatenated sounds for various instant messaging events. For instance, a sound indicating the receipt of an instant message concatenate with a personal identification sound to indicate from which sender, or a door opening/closing sound nay be played to a user (recipient) to indicate the sender is signing on or off and may be concatenated with a sound indicating precisely which sender (buddy) is signing on or off. So again, the concatenated ring tones, as disclosed, aid the recipient in audibly identifying who is sending an instant message.

As specifically set forth in Applicant's specification, *"a call control option"* is provided to the user so that the user can immediately respond to the message alert with a telecommunication function related to the event. For example, Figures 5A and 5B from Applicant's specification are shown below. The exemplary pop-up alert 5A displays the *informational status message pertaining to the contact* ("Sheila Brown's status has changed to available") and includes a *viewable call control option delivered simultaneous with the message alert* ("call"). When activated by the user, the hotspot "call" immediately places a call from the user to Sheila Brown's extension or number. The exemplary pop-up alert 5B may appear immediately after the user selects the call control option. Now the user is provided with a different informational status message ("Calling Sheila Brown at 21352) and includes different call control options pertinent to the current alert ("Hangup", "Leave Message", "Send to Voicemail"). Again, the user

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has the option to select one of the call control options to cause the telecommunication function to occur.
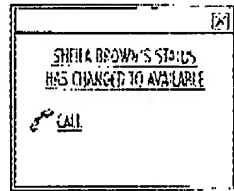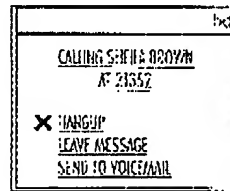


Fig. 5A          Fig. 5B

Appelman fails to disclose _an informational status message pertaining to the contact and a viewable call control option received simultaneous with the message alert_. First and foremost, Appelman discloses using sounds to identify the caller or sender. The sounds or concatenated ring tones may be used in an instant messaging or email context, but the "alert" is not a viewable informational status message pertaining to the contact and a viewable call control option. Rather, a concatenated sound _is_ the alert that may be appended to the instant message or email. Appelman is silent with respect to any "_call control options_" as claimed by Applicant, (e.g., _received simultaneous with receipt of the alert to cause a telecommunication function to occur_).

Appelman fails to disclose _an alert message delivered to the user unbeknownst to the contact_ as recited in Applicant's claims. Appelman requires the caller or sender to specify or select a particular ring tone as their identifier when placing calls. In fact, the Background identifies the problem as "land line phones are capable of sounding different ring tones that are pre-selected by the telephone company, which ring tones are not customized by the call initiator ("the caller") or by the call recipient. Appelman discloses that the concatenated ring tone is "caller-specified/defined" thus implicating that the caller selects the sound. Furthermore, the sound to be concatenated with the ring tone may be pushed by the caller [page 2, line 4]. Thus, further indicating that the alert message is delivered to the user with the caller's knowledge. The alert message is not delivered unbeknownst to the contact because it is the caller that can select the sound and push the sound to the call recipient.

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## Appelman Patent Application

As previously stated in Applicant's prior Responses, because Applicant's filing date predates the Appelman Patent Application, any additional subject matter not disclosed in the Appelman Provisional but added in the Patent Application cannot be used to anticipate Applicant's claims. Nonetheless, the Appelman Patent Application, including any new subject matter not previously disclosed, fails to teach each and every element of Applicant's claims.

Briefly, the Appelman Patent Application discloses <u>audibly identifying an event by playing, in response to a notification, at least portions of first and second sounds related to the event.</u> (Appelman Abstract; [0009])

As previously shown, Applicant claims *a viewable call control option received simultaneous with the message alert.* In fact, in the exemplary pop up alerts shown above, the viewable call control option is integrated and part of the message alert. The Examiner relies on Appelman [0008] because the sounds may be appended to an email message (which is "inherently viewable"). In Appelman, the alert (sound) is <u>not</u> the email message or instant message, but rather is a sound appended to the conversational email or instant message transmitted by the sender. The alert is not even part of the textual display received. For example, Appelman discloses that the **<u>audio identifier is a "signaling mechanism" (i.e., alert) and, therefore, is logically independent from the content of the call or the content of digital communications exchanged between the sender and the recipient</u>** [0033]. It is clear that the instant message referred to in Appelman is <u>not</u> a status alert but is a typical communication exchange between the sender and the recipient and that the alert (e.g., sound) is <u>not</u> part of the instant message but is "logically independent" from the content of the communication.

As with the Appelman Provisional, the Patent Application fails to disclose an *alert message delivered unbeknownst to the contact.* Appelman clearly recites that the caller or sender may <u>select</u> a source audio identifier and that the caller or sender of digital communications <u>pushes</u> source audio identifiers to recipients in order to personalize communication exchanges [0031]. In other words, Appelman discloses a

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two-way communication system between senders and recipients.   In contrast, Applicant's claims recite that the _informational status message is delivered to the user (i.e., recipient) unbeknownst to the contact_ and do not involve a "sender" as defined in Appelman.  The "sender" in Applicant's system is a system-generated message alert that is sent _unbeknownst to the contact for which the message pertains_.

The Examiner continues to rely on Appelman Figure 3B [0068] as demonstrating the elements of Applicant's claims.  For ease of discussion, Figure 3B is shown below.
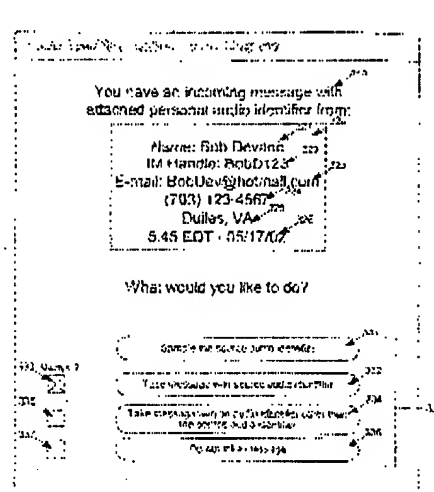


Fig. 3B

The Figure shows a user interface that is presented to the user upon _receipt of an incoming messaging with an accompanying source audio identifier_ (further demonstrating that the message and alert are logically independent).  The message or alert fail to disclose "_informational status messages pertaining to the contact_" as claimed by Applicant.  The user interface includes sender _profile_ information such as the name of the sender 321, the IM handle of sender 322, the email address of the sender 323, the direct number of the sender 324, time and date the message was sent 326, and other sender profile information 325 (e.g., the geographic location of the sender).  None of this "sender _profile_ information" provides the "_status_" of the contact as defined by Applicant's claims.

The message or alert fail to disclose "*delivered unbeknownst to the contact*" as claimed by Applicant. It is clear that the Appelman user interface was delivered to the user mindful of the contact ("sender"). In fact, the message states "You have an incoming message with attached personal audio identifier ***from: Bob Devane***" and includes the <u>sender</u> profile information (further demonstrating that the Appelman system is a two-way communication system between senders and recipients).

The message or alert fail to disclose "*a viewable call control option*" as claimed by Applicant. The user interface includes a set of option buttons 330 which, if selected by the user, allow the user to sample the source audio identifier 331, receive the message 332, or do not take the message 336. *Hence, the buttons are used to control the disposition of the current message [0069].* In contrast, the call control options claimed by Applicant are not intended to dispose of the current message, but rather cause a wholly separate telecommunication function to occur (e.g., "Call" the contact). The message alert will dispose of itself without selection of Applicant's call control options (see e.g., Applicant's claim 5 "...message alert is received for a preset amount of time..."; claim 11 "...viewing a popup window for a pre-determined time limit."; [0047]; and [0051]).

Applicant respectfully submits that the Appelman reference (Provisional and Patent Application) fail to teach each and every element of Applicant's claims. Accordingly, Applicant requests that the Examiner reconsider the cited reference and withdraw the §102(e) rejections to claims 1-18.

### Isaacs et al.

All claims, 1-18, stand rejected under 35 U.S.C. §102b as being anticipated by U.S. Application Publication No. 2002/0034281 to Isaacs et al. For the reasons stated herein, Applicant respectfully traverses.

In general, Isaacs discloses a communication system among distributed users who can send and receive short sound earcons or sound instant messages which are associated with specific conversational messages [0007]. The short communicative phrases may be any conversational message such as "Hi" or "Are you ready to go?". The alerts are earcons or melodies made up of short strings of notes. For example, a

short string of six notes could be construed to mean "Are you ready to go?" [0026]. Each user will be provided with a basic set of standardized earcons which have predefined meaning such that users may readily communicate with one another using these earcons. Additionally, users may create new earcons but it is each users responsibility to learn the other user's earcons in order to effectively communicate using these sounds [0026]. Similar to Appelman, Isaacs also discloses using personal audible Identifiers that are selected or created by users to identify the source of communications to other users over the network (Abstract). For example, a user selects a personal sound identifier which other users will hear when that user comes online or sends an instant message to another user [0012]. System users may be alerted as to the state change of other users in the system, such as when a certain user becomes "active" or changes from "active" to "idle." Such alerts are provided via sound-based alerts which will indicate the state changes to the users and may be followed by the user's personal sound identifier which identifies the user who has changed their respective state [0036].

Applicant discloses systems and methods to provide status alerts to users, *unbeknownst to the contact to whom the status alert pertains,* when a reportable event occurs. In other words, the user selects the contact(s) that the user wants to receive status alerts for and those contacts do not have to do or perform anything, such as select a personal sound identifier. In fact, the contact does not even know that alerts are being sent to the user. The user can also selectively control the level of status information desired for each contact. Additionally, the status alert includes a call-control option so that the user can immediately respond to the status alert with a telecommunication function (e.g., call the contact).

In contrast to Applicant's claims, Isaacs requires the contacts on the network to select a personal sound identifier that plays to the user when the contact initiates communication with the user. Thus, the audible alert is **not** *received by the user unbeknownst to the contact* because the contact personally selects the audible identifier and initiates communication before the alert is played. Moreover, Isaacs requires that every contact on the network learn the sound messages or earcons of every other contact in order to communicate effectively. Thus, alerts are **not** received

unbeknownst to the contact because in order to communicate both the contact and the user must know and learn each other's respective earcons [0026]. Additionally, Isaacs (like Appelman) is designed as a two-way communication system (hence, the requirement that every user *learn* the earcons of every other user) and would not function properly is there were only one recipient.

Further in contrast to Applicant's claims, Isaacs fails to disclose a *viewable call-control option* received simultaneous with the alert. In fact, Isaacs discloses audible alerts and fails to disclose any viewable alert. Isaacs does disclose using text instant messages but these are the actual conversational messages being sent to and from the network users, not textual alerts having an informational status message pertaining to the contact. In Isaacs, the earcon is a message representative of a conversational message via sound and may include another sound identifier appended to the message to indicate the source of the message. Isaacs does not disclose *an alert comprising informational status messages pertaining to the contact and a viewable call control option that causes a telecommunication function pertaining to the contact to occur.* Just to avoid any future confusion, Isaacs does disclose providing status indicators, but these are to indicate the status of the message itself and not the status of the contact or associated endpoint. For example, an acknowledgement to the sender confirms the status of the message, such as "message pending" or "message received" by the recipient [0013].

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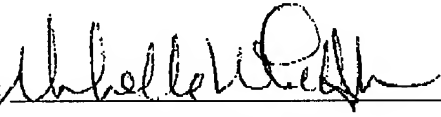Resp. dated Jan. 16, 2007

## CONCLUSION

Applicant respectfully requests withdrawal of the §102 rejections and issuance of a timely Notice of Allowance.   Should the Examiner wish to discuss any of the above in greater detail then the Examiner is invited to contact the undersigned at the Examiner's convenience.

Respectfully submitted,

Inter-Tel (Delaware), Inc.

Date: _January 16, 2007_          By: _____

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